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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Election/Restrictions*

2. Claims 8-18, 20 & 21 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on July 25, 2008.

*Drawings*

3. The drawings are objected to because reference numerals 28, 30 & 40 are used to identify features in Figs. 1-8 and then reused to identify modifications of those features in “some other embodiment” in Fig. 9. (Note the last sentence on page 13 of the amendment filed January 26, 2009.) Such usage is proscribed. See MPEP § 608.02(e).

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 recites the limitation, "all of said rolling elements that are inserted [altogether] into said roller are held in a keystone state". However, the specification teaches at page 1, line 25 through page 2, line 20, that the keystone state is achieved by inserting all but one of a plurality of rolling elements 3 in the roller 1 and thereafter inserting the last rolling element 3a. There is no teaching of how to achieve the keystone state any other way.

*Claim Rejections - 35 USC § 102*

7. Claims 1-3, 5-7 & 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Goto et al, US 5,989,124 (Goto). Fig. 1 shows a tripod constant velocity joint comprising:

a tubular outer member 1 for connection to a transmission shaft, said tubular outer member having a plurality of guide grooves 2 defined in an inner wall surface thereof which are spaced from each other and extend in an axial direction of the tubular outer member;

an inner member 4 for connection to another transmission shaft, said inner member being disposed in an opening defined in said tubular outer member; said inner member having a plurality of trunnions 5 projecting respectively into said guide grooves;

a ring-shaped roller 7 fitted over each of said trunnions and held in contact with surfaces 3 defining said guide grooves;

a plurality of rolling elements 6 rollingly interposed between each of said trunnions and said roller;

said roller having an inner circumferential wall surface  $n$ ;

a one-sided flange 9 (see Fig. 7) projecting radially from an axial end of said inner circumferential wall surface; and

a holder 8 mounted in an opposite axial end of said inner circumferential wall surface and holding said rolling elements;

wherein Figs. 26-28 show that before said holder is mounted in said roller, all rolling elements are inserted altogether as an annular array into said roller and placed onto said inner circumferential wall surface in an axial direction of said inner circumferential wall surface from the axial end thereof remote from said one-sided flange, and are retained in place.

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Fig. 28 shows all rolling elements 6 which are inserted into said roller 7 are held in a keystone state on said inner circumferential wall surface.

Fig. 26 shows a radial clearance (nominally indicated by the reference character 10a) is defined between said inner circumferential wall surface of said roller 72 and outer circumferential surfaces of said rolling elements 6.

Fig. 1 shows the holder comprises a washer 8.

Fig. 7 shows the one-sided flange comprises a flange 9 integrally formed with said roller 70.

Fig. 1 shows the one-sided flange is provided by a holder comprising at least a washer 8.

#### *Claim Rejections - 35 USC § 103*

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goto. Fig. 26 shows a radial clearance (nominally indicated by the reference character 10a), but does not expressly disclose the clearance in a range from several  $\mu\text{m}$  to several tens of  $\mu\text{m}$ . However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the clearance in a range from several  $\mu\text{m}$  to several tens of  $\mu\text{m}$ , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056.

#### *Response to Arguments*

9. Applicant's arguments filed January 26, 2009 have been fully considered but they are not persuasive:

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a. Applicant argues that Goto fails to anticipate claim 1 because it does not disclose all the rolling elements being inserted together. However, the patentability of a product, such as a tripod constant velocity joint, does not depend on its method of production.

When the product in a product-by-process claim, such as instant claim 1, is the same as the product of the prior art, the claim is unpatentable. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See also MPEP § 2113.

b. Applicant argues that Goto fails to anticipate claim 19 because it does not disclose all the rolling elements being inserted together. However, Goto does disclose inserting the rolling elements so that they're held in the keystone effect and the method it discloses is the same as that disclosed by applicant. So Goto discloses all the rolling elements being inserted together to the same extent applicant discloses same.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 10:30 am to 8:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Binda/  
Primary Examiner, Art Unit 3679